

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of : Richard Douglas Kemp
Application No. : 10/603,207
Filing Date : June 25, 2003
Art Unit : 2166
Title : Electronic Management and Distribution of Legal Information

Attorney : 336001-2024.1
Docket No. :

Mail Stop Appeal Brief—Patents
Commissioner for Patents
PO Box 1450
Alexandria VA 22313-1450

REPLY BRIEF

I. ARGUMENT

Patent examination follows certain rules. During examination, patent claims must be given their broadest reasonable interpretation consistent with the specification. MPEP § 2111. A reference may be relied on for all that it would have reasonably suggested to one having ordinary skill in the art. MPEP § 2123(I). The examiner continues to ignore these rules, and the Board must therefore reverse the rejections of the pending claims.

For example, claim 7 requires, among other things, that the computer automatically access and display new legal information responsive to a request while previously accessed responsive information is provided for display on a display device. In this connection, the examiner cites a mention in Lee of providing up-to-date business/legal information to any user, *upon request*. (Examiner's Brief at 19.) The examiner further asserts that the system in Lee will, *in response to a user's selection* of a link labeled "Today's News," "automatically access the database to retrieve new information for the date and display it to the user." *Id.*

This is extraordinary. In common usage, the word "automatically" pertains to events happening without conscious intervention. For example, one popular dictionary defines "automatic" as "[a]cting or operating in a manner essentially independent of external influence or control" and "[a]cting or done without volition or conscious control." THE AMERICAN HERITAGE COLLEGE DICTIONARY 93 (3rd ed. 1993). Yet the examiner, rejecting a claim requiring that something be done automatically, asserts it to be anticipated by a discussion of something that happens only in response to a user's conscious request. The examiner holds that a claim limitation is anticipated by a description of *its exact opposite*. The Board cannot let this stand.

Similar problems permeate the arguments in the Examiner's Brief. As another example, claim 1 requires, among other things, that a database store legal information in association with a plurality of legal topics and a plurality of types of legal information. In connection with this limitation, the examiner cites Lee at col. 2, lines 7-15, which includes: "In one aspect, the present invention is a method that includes . . . storing legal/business information in a central database." (Examiner's Brief at 15.)

But the limitation is not simply that legal information be stored in a database. The information must be stored in association with a plurality of legal topics and a plurality of types of legal information. And the examiner in no way addresses the applicant's showing that Lee does not disclose such association, or even any way such association could be created or maintained. Indeed, the examiner does not even address the existence of the limitation.

Nor does the examiner address the applicant's showing that Lee fails to teach so much as the existence of a plurality of legal topics, such as the items of legal information might be stored in association with. Instead, the examiner returns again to the list of practice groups in Fig. 6 of Lee. (Examiner's Answer at 15.) But claim 1 specifies "a plurality of legal topics," *not* "a plurality of things, some of which have the same names as legal topics."

The distinction is real and important. A limitation specifying "a plurality of kinds of horses," for example, would not be anticipated by a catalog of car models produced by the Ford Motor Company, even though that catalog would include the words "Mustang" and "Pinto." By focusing exclusively on the identities of the words, the examiner continues to miss the point, which is the identities of the referents. The examiner's failure to recognize this distinction is erroneous and sufficient ground to require the Board to reverse the claim rejections.

The examiner also fails to rebut the applicant's showing that Lee fails to teach a plurality of types of legal information. The applicant has already shown that "types of legal information" refers to a classification based on the legal import of the classified items. Ignoring this showing, the examiner says only that "Lee's Fig. 6 organized items of legal information under different groups with different headings in tabulated format, and therefore anticipates the claimed limitation 'tabulated by type of legal information.'" The examiner's position seems to be that any grouping, under headings, of items such as Lee displays is, as such, an establishment of types of legal information and tabulation of the items by such types.

The examiner's position is not merely inconsistent with the specification: it is unreasonable and inconsistent with the interpretation *anyone* would give to the term. Illustrating the incorrectness of the examiner's position, for example, a collection of files may represent legal briefs and may be in different formats. For example, some may be plain text, some may be marked up in HTML for display as Web pages, and some may be in a format used by a word

processor, such as Microsoft Word. The files in such an example could be considered legal information, and a listing of those files grouped by file format could be considered a tabulation of the files by type.

But *no one*, whether skilled in a relevant art or not, would use the term “type of legal information” to describe any such grouping. This is because the grouping would be independent of any characteristic of the information that makes it legal information. Reliance on such a characteristic is the difference between a “type” and a “type of legal information.”

The examiner may interpret claim terms broadly, but any interpretation must be reasonable and consistent with the specification. MPEP § 2111. It must also be consistent with the interpretation that those skilled in the art would reach. *Id.* Here, however, the examiner has read the words “of legal information” out of claim limitations that refer to “types of legal information.” The consequent interpretation is inconsistent with any reasonable interpretation that anyone would reach.

Moreover, given a reasonable interpretation of the claim terms, Lee fails to anticipate any claim. Fig. 6, for example, which the examiner relies on, does include several items under several headings. But some headings, including, *e.g.*, “Our Organization” and “Quality,” on their faces have nothing to do with any legal subject matter. Many items classified under these headings, including, *e.g.*, “Global Sales Representatives Database,” “BWH Vision/Career Development,” and “Current Open Positions” manifestly have nothing to do with legal subject matter. Considering these facts, the classification of items in Fig. 6 cannot reasonably be considered to reflect any aspect of the legal subject matter of any classified information.

Referring again to Fig. 6 of Lee, the examiner asserts that this figure illustrates types of legal information, including “News” and “Secondary Information. (Examiner’s Brief at 17.) This position has many flaws. At the outset, although the word “news” does appear in Fig. 6, the figure does not include anything that could reasonably designate secondary legal material. As used in the legal art, primary material generally refers to authoritative sources of legal information such as, *e.g.*, statutes, administrative regulations, and judicial opinions, and “secondary material” usually refers to matter that builds on, *e.g.*, summarizes, explains, or indexes, the primary material. For example, the specification recites law journal articles as an

example of secondary materials. (Application at 1, ¶ 0004.) Nothing even suggesting such material is to be found in Fig. 6.

Nor does Fig. 6 of Lee teach news or secondary information as types of legal information. As the applicant has shown repeatedly, to be regarded as a type of legal information, a class must exist, and membership in that class must be based upon some aspect of the legal characteristics of that information. The examiner has failed to show anything in Fig. 6 that could be regarded as secondary information, and consequently no classification referring to “secondary information” could be taught, either. Nor does anything about the term “news” in Fig. 6 teach or suggest that the term is used to refer to a type of legal information.

In sum, the examiner has failed to show that Lee teaches or suggests the mere existence of a plurality of legal topics or a plurality of types of legal information, as claim 1 requires. Even if such topics and types could be shown to exist in Lee, claim 1 further requires that items of legal information be stored in a database in association with the plurality of topics and the plurality of types, and the examiner has failed to show that Lee teaches or suggests such associations. The Board must therefore reverse the rejection of all pending claims.

Claim 1 further requires the presentation of items of legal information tabulated by type of legal information. But the examiner has failed to show tabulation by type of legal information. For example, the examiner refers to “news” and “secondary information” in Fig. 6, but no item of any kind is tabulated under either type.

The examiner’s only other reference to the tabulation of information by type of legal information involves the list of practice groups under the heading “Practice Groups.” (Examiner’s Answer at 18.) The applicant has already demonstrated the many flaws in this argument. For example, a practice group is not a type of legal information; it is a group of people in a larger organization who work together.

Moreover, the items listed under this heading are the names of practice groups in the organization. But the examiner already treats the listed items as the plurality of legal topics that claim 1 requires. The applicant has shown that nothing can fill both roles, and the examiner has not even tried to rebut that argument. The examiner therefore needs to decide whether these

items are the items of legal information that claim 1 requires or the plurality of legal topics that claim 1 also requires. Whichever alternative the examiner chooses, however, Lee will fail to teach or suggest at least the other limitation of claim 1, and the rejection of that claim over Lee is therefore in error.

II. CONCLUSION

In view of the foregoing, it is believed that all pending claims are in proper condition for allowance, and the Board is respectfully requested to overturn the Examiner's rejection of these claims.

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Respectfully submitted,

Customer No. 20999

Frommer Lawrence & Haug LLP
745 Fifth Avenue
New York, NY 10151
Tel. (212) 588-0800
Fax (212) 588-0500

/Jon E. Gordon/

Jon E. Gordon
Reg. No. 55,217
Attorney for Applicant